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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,177	12/18/2000	Hollis Newcomb White	7552	7460

7590

07/29/2003

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EXAMINER

ELEY, TIMOTHY V

ART UNIT

PAPER NUMBER

3724

DATE MAILED: 07/29/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/740,177

Applicant(s)

WHITE, HOLLIS NEWCOMB *LN*

Examiner

Timothy V Eley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2002, and 12 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,13-16,24-26 and 28-41 is/are pending in the application.
- 4a) Of the above claim(s) 29 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2,24-26 and 31-41 is/are allowed.
- 6) ☒ Claim(s) 13-16,28 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 30 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. Claim 30 as amended is not fully understood. How can a circumference extend from 0-100 of the rotary fine grinding wheel(i.e. how can a circumference be 0)?

Claim Rejections - 35 USC § 102

3. Claims 13-16, and 28 rejected under 35 U.S.C. 102(b) as being anticipated by Onodera as applied in the rejection on page 3 of paper number 7.
4. Claim 30 is rejected under 35 U.S.C. 102(e) as being anticipated by Hornby et al.

- a. Claim 30, as far as it is understood, is rejected under 102(e) as clearly anticipated by Hornby et al. See specifically figure 4.

Response to Arguments

5. Applicant's arguments filed November 27, 2002 have been fully considered but they are not persuasive.

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a. Applicant argues that the Onodera patent does not disclose any teaching of dressing the fine grinding surface to a convex shape.

i. The Onodera apparatus is capable of dressing the fine grinding surface to convex shapes as recited by applicant.

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

b. Applicant argues that claims 13-16, 28, and 29 recited dressing "the fine grinding surface to a convex shape".

i. However, claim 28 does not recite such a limitation. Hopefully applicant does not truly believe that a recitation of "(i)n a system utilizing a grinding wheel, the improvement of a dresser and movement means to move said dresser in respect to the grinding wheel" is patentable subject matter. It is believed that claim 28 is merely an oversight by applicant.

c. Applicant argues that modifying Onodera to produce anything other than a uniform flat surface is against the teachings thereof by purposely varying the surfaces of the grinding wheels from a "known value".

i. It should be noted that the Onodera apparatus does not need to be modified in order to produce a convex surface.

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The Onodera apparatus is capable of producing a convex surface as broadly recited by applicant.

d. Applicant argues that claim 30 has been amended to recite that the outer extent extends "from 0-100% of the fine grinding wheel".

i. However, applicant recites, "an outside circumference with an outer extend extending from 0-100 of the rotary fine grinding wheel". It is not readily apparent as to exactly what is meant by an outside circumference with an outer extent extending from 0-100 of the rotary fine grinding wheel.

e. Applicant argues that there is no teaching of a convex shape in the Hornby reference.

i. However, figure 2 clearly discloses a convex shape which is 20-40% of the outer extent of the grinding wheel.

Allowable Subject Matter

8. Claims 2,24-26, and 31-41 are allowed.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

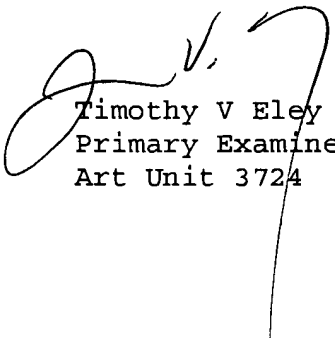
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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy V Eley whose telephone number is 703-308-1824. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N Shoap can be reached on 703-308-1082. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



Timothy V Eley
Primary Examiner
Art Unit 3724

tve
July 27, 2003